### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE Atty. Docket No. REQUEST FOR CORRECTED FILING RECEIPT LIBRE1100-6 In re Application of: Tracey L. Jones Application Number: Filing or 371(c) Date: 09/690,368 10/16/2000 For: METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT FOR DISPLAYING A VERSION OF A PAPER (AS AMENDED) Group Art Unit: 2178 Confirmation No. 3107 Certificate of Transmission Under 37 C.F.R. § 1.8 Commissioner for Patents P.O. Box 1450 I hereby certify that this correspondence is being deposited electronically with the U.S. Patent and Trademark Office using the United States Patent and Alexandria, VA 22313-1450 Trademark Office's EFS-Wgb system on \_\_\_\_ Dear Sir:

- 1. Attached is a copy of the official corrected filing receipt received from the PTO in the above application for which issuance of a corrected filing receipt is respectfully requested.
- 2. There is an error with respect to the following data, which is:

×	Incorrectly entered	and/or
	Omitted	

		Error in		Correct data
A.	X	Priority Information	A.	Incorrect: 60/208,515 filed 06/01/2000; should be 60/208,015 filed 05/26/2000; see attached Supplemental Declaration submitted 06/11/2000 and Preliminary Amendment submitted June 7, 2001.
B.		Inventor's Info.	B.	
C.	X	Title	C.	METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT FOR DISPLAYING A VERSION OF A PAPER; see attached Response to Office Action submitted October 26, 2005.
D.		Filing Date	D.	1
E.		Other	E.	

July 2b, 2011

Date

Ari@kmal

Reg. No. 51,388



### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS PO. Box 1450 Alexandria, Vigginia 22313-1450

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
09/690.368	10/16/2000	2178	491	28150 11	27	2/	

27685 HAYNES AND BOONE, LLP 600 CONGRESS AVENUE **SUITE 1600** AUSTIN, TX 78701

CONFIRMATION NO. 3107 CORRECTED FILING RECEIPT \*OC000000013972448\*

\*OC00000013972448\*

Date Mailed: 10/01/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Tracey L. Jones, Austin, TX; Billy P. Taylor, Cedar Park, TX; Frank H. Moeller, Austin, TX:

Power of Attorney: The patent practitioners associated with Customer Number 27685.

Domestic Priority data as claimed by applicant  $\rho$ 

Foreign Applications

This appln claims benefit of 60/208, \$15 06/01/2000 cations (00/208, 0.15 05/26/2000)

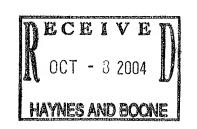
If Required, Foreign Filing License Granted: 12/05/2000

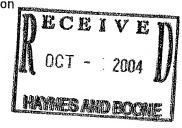
The number of your priority application, to be used for filing abroad under the Paris Convention is, US09/690,368

Projected Publication Date: None, application is not eligible for pre-grant publication

Non-Publication Request: No

Early Publication Request: No





\*\* SMALL ENTITY \*\*

Title

Method and system for displaying a digital version of a mass-produced printed paper

**Preliminary Class** 

715

# LICENSE FOR FOREIGN FILING UNDER Title 35, United States Code, Section 184 Title 37, Code of Federal Regulations, 5.11 & 5.15

#### **GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

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### **NOT GRANTED**

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PATENT / DOCKET NO.: 28150.11

### SUPPLEMENTAL DECLARATION

As below named inventors, we hereby declare that:

Our residence, post office address and citizenship are as stated below next to our names;

We believe we are the original, first and sole joint inventors of the subject matter which is claimed and for which a patent is sought on the invention entitled

### METHOD AND SYSTEM FOR DISPLAYING A DIGITAL VERSION OF A MASS-PRODUCED PRINTED PAPER

the specification	n of which: (check one)
	is attached hereto.
XXX	was filed on October 16, 2000 under Attorney's Docket Number 28150.11 as Application Serial No. 09/690,368 and was amended on (if applicable).
We hereby state including the cla	that we have reviewed and understand the contents of the above identified specification, aims, as amended by any amendment referred to above.
	e the duty to disclose information which is material to the patentability of this application ith 37 CFR 1.56.
made on informathe knowledge the of both, under 1	are that all statements made herein of our own knowledge are true and that all statements ation and belief are believed to be true; and further that these statements were made with hat willful false statements and the like so made are punishable by fine or imprisonment, 8 USC 1001 and that such willful false statements may jeopardize the validity of the my patent issued thereon.
	n the benefit under Title 35, United States Code, § 119(e) of any United States ication(s) listed below.
60/208,015	May 26, 2000
(Application Nu	

PATENT / DOCKET NO.: 28150.11

DATED: 5-30-01

POWER OF ATTORNEY: As a named inventor, we hereby appoint the following attorneys and/or agents to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

Theodore Baroody Jeffrey M. Becker James R. Bell L. Howard Chen Randall E. Colson Michael A. Davis, Jr. Ruben C. DeLeon Brian J. Hubbard Rita M. Irani	Reg. No. 45,417 Reg. No. 35,442 Reg. No. 26,528 Reg. No. 46,615 Reg. No. 40,566 Reg. No. 35,488 Reg. No. 37,812 Reg. No. 45,873	Michael J. Balconi-Lamica Todd Mattingly David L. McCombs John W. Montgomery Bill R. Naifeh David M. O'Dell Phillip B. Philbin Constance M. Pielech	Reg. No. 34,291 Reg. No. 40,298 Reg. No. 32,271 Reg. No. 31,124 Reg. No. 44,962 Reg. No. 42,044 Reg. No. 35,979 Reg. No. 46,991
•	, •	± .	_

Send correspondence to <u>Christopher P. Kosh</u>, Haynes and Boone, LLP,, 600 Congress Avenue, Suite 1600, Austin, Texas 78701 and direct all telephone calls to Christopher P. Kosh at 512/867-8400.

FULL NAME OF INVENTOR: Tracey L. Jones

INVENTOR'S SIGNATURE

RESIDENCE: 12012 Portofino Drive, Austin, Texas 78732

CITIZENSHIP: United States of America

POST OFFICE ADDRESS: 12012 Portofino Drive, Austin, Texas 78732

PATENT / DOCKET NO.: 28150.11

FULL NAME OF INVENTOR: Billy P. Taylor
INVENTOR'S SIGNATURE: Signature: Dated: 30 Ma, 200)
RESIDENCE: 1302 Spotted Fawn Cove, Cedar Park, Texas 78613
CITIZENSHIP: United States of America
POST OFFICE ADDRESS: 1302 Spotted Fawn Cove, Cedar Park, Texas 78613
FULL NAME OF INVENTOR: Frank H. Moeller
INVENTOR'S SIGNATURE: Alache DATED: 5/30/6/
RESIDENCE: 4034 Ravine Ridge Trail, Austin, Texas 78746
CITIZENSHIP: United States of America
POST OFFICE ADDRESS: 4034 Ravine Ridge Trail, Austin, Texas 78746

a-114244.1



### PATENT

Docket No.: 28150.11

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re p	atent application of: Jones, T. et al.	§ §	
Serial l	No.: 09/690,368	8 8 8	Group Art Unit: 2176
Filed:	October 16, 2000	8 8 8	Examiner: Unknown
For:	METHOD AND SYSTEM FOR DISPLAYING A DIGITAL VERSION OF A MASS-PRODUCED PRINTED PAPER	8 8 8	

Box Non-Fee Amendment Commissioner for Patents Washington, D.C. 20231

### PRELIMINARY AMENDMENT

Sir or Madame:

Please enter the following preliminary amendment.

Docket No.: 28150.11

### IN THE SPECIFICATION

Please delete the paragraph on page 1, lines 5-9 and insert the following paragraph therefor:

-- This application claims priority to U.S. Provisional Patent Application No. 60/208,015, filed May 26, 2000, entitled SYSTEM AND METHOD FOR PREPARING PRINTED MATTER FOR DELIVERY TO PERSONAL COMPUTERS naming Billy P. Taylor as inventor. --

Docket No.: 28150.11

Please delete the paragraph on page 1, lines 5-9 and insert the following paragraph therefor:

-- This application claims priority to U.S. Provisional Patent Application No. <u>60/208,015</u> [60/208,515], filed May 26, 2000, entitled SYSTEM AND METHOD FOR PREPARING PRINTED MATTER FOR DELIVERY TO PERSONAL COMPUTERS naming Billy P. Taylor as inventor. --

Docket No.: 28150.11

Applicants respectfully requests entry of the above amendment.

The Commissioner is hereby authorized to charge payment of any fees associated with any of the papers submitted herewith to Deposit Account No. 08-1394.

HAYNES AND BOONE, L.L.P.

600 Congress Avenue, Suite 1600

Austin, Texas 78701

Telephone: [512] 867-8510 Facsimile: [512] 867-8470

a-114481.1

Respectfully submitted,

Christopher P. Kosh

Registration No. 42,760

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, Washington, D.C. 20231



## CENTRAL FAX CENTER

OCT 2 7 2005

### Fax Transmittal

DATE: October 26, 2005

Total Pages (including this cover page): 21

To:

Commissioner for Patents

Examiner:

Matthew J. Ludwig

Fax No.:

Serial No.:

571-273-8300 09/690,368

From:

Michael A. Davis, Jr.

Davis Law Group, P.C.

Direct Phone No.: (512) 306-8324

9020 N. Capital of Texas Hwy.

Direct Fax No.:

(512) 306-8374

Bldg. I. Suite 375

E-mail:

michael.davis@LegalVP.com

Austin, Texas 78759

If you have any problem with this transmittal, please call: (512) 306-8324

Serial No.: 09/690,368 Filed: October 16, 2000

Title: METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT FOR DISPLAYING A

**VERSION OF A HARDCOPY PAPER** 

Attorney Docket No.: 1005.11

Dear Sir or Madam:

Attached please find the following regarding the above-referenced patent application:

1. Transmittal letter, in duplicate; and

2. Response to Office Action.

Entry of these papers in the above referenced application is courteously solicited. Any question regarding this matter should be directed to the undersigned.

Registration No. 35,488

Confidentiality Note: The information contained in this facsimile message is privileged and confidential and is intended only for the use of the addressee. The term "privileged and confidential" includes, without limitation, attorney-client privileged communications, attorney work product, trade secrets, and any other proprietary information. Nothing in this facsimile is intended by the attorney or the client to constitute a waiver of the confidentiality of this message. If the reader of this message is not the intended recipient, or employee/agent of the intended recipient, you are hereby notified that any duplication, or distribution of this communication is unauthorized. If you have received this message in error, please notify us by telephone immediately so that we can arrange for the return of the original documents to us at no cost to you.

Group Art Unit: 2178

Examiner: Ludwig, M.

Confirmation No.: 3107

Serial No.: 09/690,368

Response to Office Action of 07/26/2005

Docket No. 1005,11 Customer No. 53953

### RECEIVED

In re application of:

Tracey L. Jones, et al.

Serial No.: 09/690,368

Filed: October 16, 2000

For: METHOD, SYSTEM AND

> COMPUTER PROGRAM PRODUCT FOR DISPLAYING A VERSION OF A

HARDCOPY PAPER

Mail Stop Amendment

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed July 26, 2005, enclosed are the following regarding the above-identified patent application:

\$ \$ \$ \$ \$ \$ \$ \$ \$ \$ \$ \$ \$

- 1. Transmittal letter (in duplicate); and
- 2. Response to Office Action.
- [X] Small entity status of this application has previously been established.
- [ ] No additional fee is required.

The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	SMALL	ENTITY		OTHER SMALL		
	CLAIM REMAI AFTER AMENI	NING	HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA		RATE A	DDIT.	OR	RATE FEE	ADDIT.
TOTAL	45	minus	24	= 21	x 25	\$ <u>525</u>	OR	x 50	\$	-
INDEP	9	minus	3	= 6	x 100	\$_600_	OR	x 200	\$	<b></b>
FIRST P	RESENT	O MOITA	F MULTIPLE DEP	. CLAIM	+ 180	S	OR	+ 360	\$	-
					TOTAL	\$ <u>1.125</u>	OR	TOTAL	\$	-

[X] Please charge Deposit Account No. 50-3524 in the amount of \$1,125...

Response to Office Action of 07/26/2005

Docket No. 1005.11 Customer No. 53953

- [X] The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-3524.
  - Any additional filing fees under 37 C.F.R. § 1.16 for the presentation of extra claims. [X]
  - [X] [X] Any patent application processing fees under 37 C.F.R. § 1.17.
  - A copy of this sheet is enclosed.

Respectfully submitted,

Registration No. 35,488

Date: October 26, 2005 Davis Law Group, P.C. 9020 N. Capital of Texas Hwy. Bldg. 1, Suite 375 Austin, Texas 78759 Telephone 512-306-8324 Facsimile 512-306-8374 Docket Number: 1005.11

	I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below;
	Fax Number: <u>571-273-8300</u>
i	Michael A, Davis, Jr. TYPE OR PRINT NAME
	12-62. 2.11
1	SIGNATURE
	October 26, 2005 DATE OF TRANSMISSION

Response to Office Action of 07/26/2005

Docket No. 1005.11 Customer No. 53953

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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OCT 2 7 2005

In re application of:

Tracey L. Jones, et al.

Serial No.: 09/690,368

Filed: October 16, 2000

For: METHOD, SYSTEM AND

COMPUTER PROGRAM PRODUCT FOR DISPLAYING A VERSION OF A

HARDCOPY PAPER

Group Art Unit: 2178

Examiner: Ludwig, M.

Confirmation No.: 3107

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

### RESPONSE TO OFFICE ACTION

In response to the Office Action mailed July 26, 2005, please reconsider this application in view of the following remarks.

Amendments to the Specification begin on page 2 of this paper.

Listing of Claims section begins on page 3 of this paper.

Remarks section begins on page 13 of this paper.

10/28/2005 NBINAS 00000006 503524 , 09690368

01 FC:2202

202 525.00 DA

02 FC:2201 600.00 DA

Response to Office Action of 07/26/2005

Docket No. 1005.11 Customer No. 53953

### Amendments to the Specification

Please delete the title in its entirety and substitute the following replacement title in place thereof.

--METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT FOR DISPLAYING A VERSION OF A HARDCOPY-PAPER--

Response to Office Action of 07/26/2005

Docket No. 1005.11 Customer No. 53953

### **Listing of Claims**

The following listing of claims will replace all prior versions, and listings, of claims in the application.

 (Currently amended) A method performed by a computer system, comprising: storing an electronic version of a hardeopy-paper, the electronic version being displayable on a display device as a likeness of the paper, wherein the paper is at least one of the following: a newspaper; and a magazine; and a journal;

at a first location within the electronic version, in response to displayable content of the likeness; detecting a reference to at a first location within the displayable content of the likeness; the detected reference being associated with a second location, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and

in response to the detected reference, embedding a hyperlink within the version between the first location, wherein the hyperlink is and the second location, and the first location being: displayable on the display device as part of the likeness; highlighted to indicate the hyperlink; and selectable by a user to cause an operation associated with the second location.

(Previously presented) The method of Claim 1 and comprising:
 on the display device, displaying a first selector associated with a first portion of the paper;

on the display device, displaying a second selector associated with a second portion of the paper; and

on the display device, displaying a likeness of the first portion in response to a selection of the first selector.

Response to Office Action of 07/26/2005

Docket No. 1005.11 Customer No. 53953

3. (Currently amended) A method performed by a computer system The method of Claim 1 and, comprising:

on a first date, receiving a watch list term that is specified by a user;

receiving an electronic version of a paper on a second date after the first date, and searching the electronic version for the watch list term, without the user specifying the watch list term after the first date, and without the user initiating the searching after the first date; and outputting displaying a result of the searching for display on a display device.

4. (Currently amended) The method of Claim 3 and comprising:

in response to a selection of the result, displaying a likeness of a portion of the paper associated with the selected result-on the display device, wherein the watch list term is located in the portion.

- 5. (Previously presented) The method of Claim 1 and comprising: on the display device, in response to a user command, performing a pan function on the likeness of the paper.
- 6. (Previously presented) The method of Claim 1 and comprising: on the display device, in response to a user command, performing a zoom function on the likeness of the paper.
- 7. (Currently amended) The method of Claim 1 and comprising:
  in response to a selection of a portion of the <u>electronic</u> version, displaying the portion on the display device as a likeness of the paper in an enlarged format.
- 8. (Currently amended) The method of Claim 1, wherein the first location is highlighted by an indicator to indicate the hyperlink, and comprising:

  in response to a user command, selecting a type of the indicator.

Response to Office Action of 07/26/2005

Docket No. 1005.11 Customer No. 53953

- (Currently amended) A system, comprising:
- a computing device for:
- storing an electronic version of a hardeepy paper, the electronic version being displayable on a display device as a likeness of the paper, wherein the paper is at least one of the following: a newspaper; and a magazine; and a journal;
- at a first location within the electronic version, in response to displayable content of the likeness, detecting a reference to at a first location within the displayable content of the likeness, the detected reference being associated with a second location, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
- in response to the detected reference, embedding a hyperlink within the version between the first location, wherein the hyperlink is and the second location, and the first location being: displayable on the display device as part of the likeness; highlighted to indicate the hyperlink; and selectable by a user to cause an operation associated with the second location.
- 10. (Previously presented) The system of Claim 9 wherein the computing device is for:

on the display device, displaying a first selector associated with a first portion of the paper;

on the display device, displaying a second selector associated with a second portion of the paper; and

on the display device, displaying a likeness of the first portion in response to a selection of the first selector.

Response to Office Action of 07/26/2005

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11. (Currently amended) A system, comprising: The system of Claim 9 wherein the a computing device is for:

on a first date, receiving a watch list term that is specified by a user;

receiving an electronic version of a paper on a second date after the first date, and searching the electronic version for the watch list term, without the user specifying the watch list term after the first date, and without the user initiating the searching after the first date; and

outputting displaying a result of the searching for display on a display device.

12. (Currently amended) The system of Claim 11 wherein the computing device is for:

in response to a selection of the result, displaying a likeness of a portion of the paper associated with the selected result on the display device, wherein the watch list term is located in the portion.

13. (Previously presented) The system of Claim 9 wherein the computing device is for:

on the display device, in response to a user command, performing a pan function on the likeness of the paper.

14. (Previously presented) The system of Claim 9 wherein the computing device is for:

on the display device, in response to a user command, performing a zoom function on the likeness of the paper.

15. (Currently amended) The system of Claim 9 wherein the computing device is for: in response to a selection of a portion of the <u>electronic</u> version, displaying the portion on the display device as a likeness of the paper in an enlarged format.

Response to Office Action of 07/26/2005

Docket No. 1005.11 Customer No. 53953

- 16. (Currently amended) The system of Claim 9, wherein the first location is highlighted by an indicator to indicate the hyperlink, and wherein the computing device is for: in response to a user command, selecting a type of the indicator.
- 17. (Currently amended) A computer program product, comprising:
  a computer program processable by a computer system for causing the computer system to:
  - store an electronic version of a hardeopy-paper, the electronic version being displayable on a display device as a likeness of the paper, wherein the paper is at least one of the following: a newspaper; and a journal;
  - at a first location within the electronic version, in response to displayable content
    of the likeness, detect a reference to at a first location within the
    displayable content of the likeness, the detected reference being associated
    with a second location, and wherein the detected reference is at least one
    of the following, other than a computer network address: an alphanumeric
    character; a symbol; a term; and a phrase; and
  - in response to the detected reference, embed embedding a hyperlink within the version-between the first location, wherein the hyperlink is and the second location, and the first location being: displayable on the display device as part of the likeness; highlighted to indicate the hyperlink; and selectable by a user to cause an operation associated with the second location; and apparatus from which the computer program is accessible by the computer system.
- 18. (Previously presented) The computer program product of Claim 17 wherein the computer program is processable by the computer system for causing the computer system to: on the display device, display a first selector associated with a first portion of the paper; on the display device, display a second selector associated with a second portion of the paper; and

on the display device, display a likeness of the first portion in response to a selection of the first selector.

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19. (Currently amended) <u>A The-computer program product of Claim 17 wherein the comprising:</u>

<u>a</u> computer program is-processable by <u>a</u> the-computer system for causing the computer system to:

on a first date, receive a watch list term that is specified by a user;

receive an electronic version of a paper on a second date after the first date, and

search the electronic version for the watch list term, without the user

specifying the watch list term after the first date, and without the user

initiating the search after the first date; and

output display a result of the searching for display on a display device; and apparatus from which the computer program is accessible by the computer system.

- 20. (Currently amended) The computer program product of Claim 19 wherein the computer program is processable by the computer system for causing the computer system to: in response to a selection of the result, display a likeness of a portion of the paper associated with the selected result on the display device, wherein the watch list term is located in the portion.
- 21. (Previously presented) The computer program product of Claim 17 wherein the computer program is processable by the computer system for causing the computer system to: on the display device, in response to a user command, perform a pan function on the likeness of the paper.
- 22. (Previously presented) The computer program product of Claim 17 wherein the computer program is processable by the computer system for causing the computer system to: on the display device, in response to a user command, perform a zoom function on the likeness of the paper.

Response to Office Action of 07/26/2005

Docket No. 1005.11 Customer No. 53953

23. (Currently amended) The computer program product of Claim 17 wherein the computer program is processable by the computer system for causing the computer system to:

in response to a selection of a portion of the <u>electronic</u> version, display the portion on the display device as a likeness of the paper in an enlarged format.

24. (Currently amended) The computer program product of Claim 17, wherein the first location is highlighted by an indicator to indicate the hyperlink, and wherein the computer program is processable by the computer system for causing the computer system to:

in response to a user command, select a type of the indicator.

- 25. (New) The method of Claim 1, wherein the second location is located within the electronic version.
- 26. (New) The method of Claim 25, wherein the detected reference includes a page number of the second location.
- 27. (New) The method of Claim 1, wherein the operation includes displaying the second location on the display device.
- 28. (New) The method of Claim 1, wherein the electronic version is a second electronic version of the paper, and comprising:

translating a first electronic version of the paper into the second electronic version.

- 29. (New) The method of Claim 1, and comprising: forming a link table in the electronic version; and in the link table, storing information associated with the hyperlink.
- 30. (New) The method of Claim 8, wherein the first location is highlighted by an indicator to indicate the hyperlink, and comprising:

in response to a user command, selecting a type of the indicator.

Response to Office Action of 07/26/2005

Docket No. 1005.11 Customer No. 53953

- 31. (New) The system of Claim 9, wherein the second location is located within the electronic version.
- 32. (New) The system of Claim 31, wherein the detected reference includes a page number of the second location.
- 33. (New) The system of Claim 9, wherein the operation includes displaying the second location on the display device.
- 34. (New) The system of Claim 9, wherein the electronic version is a second electronic version of the paper, and wherein the computing device is for translating a first electronic version of the paper into the second electronic version.
  - 35. (New) The system of Claim 9, wherein the computing device is for: forming a link table in the electronic version; and in the link table, storing information associated with the hyperlink.
- 36. (New) The system of Claim 16, wherein the first location is highlighted by an indicator to indicate the hyperlink, and wherein the computing device is for:
  in response to a user command, selecting a type of the indicator.
- 37. (New) The computer program product of Claim 17, wherein the second location is located within the electronic version.
- 38. (New) The computer program product of Claim 37, wherein the detected reference includes a page number of the second location.
- 39. (New) The computer program product of Claim 17, wherein the operation includes displaying the second location on the display device.

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40. (New) The computer program product of Claim 17, wherein the electronic version is a second electronic version of the paper, and wherein the computer program is processable by the computer system for causing the computer system to:

translate a first electronic version of the paper into the second electronic version.

41. (New) The computer program product of Claim 17, wherein the computer program is processable by the computer system for causing the computer system to:

form a link table in the electronic version; and in the link table, store information associated with the hyperlink.

42. (New) The computer program product of Claim 24, wherein the first location is highlighted by an indicator to indicate the hyperlink, and wherein the computer program is processable by the computer system for causing the computer system to:

in response to a user command, select a type of the indicator.

43. (New) A method performed by a computer system, comprising:

storing an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper, wherein the paper is at least one of the following: a newspaper; a magazine; and a journal;

at a first location within the electronic version, detecting a reference to a second location within the electronic version, wherein the detected reference includes a page number of the second location; and

in response to the detected reference, embedding a hyperlink within the first location, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device.

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### 44. (New) A system, comprising:

a computing device for:

- storing an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper, wherein the paper is at least one of the following: a newspaper; a magazine; and a journal;
- at a first location within the electronic version, detecting a reference to a second location within the electronic version, wherein the detected reference includes a page number of the second location; and
- in response to the detected reference, embedding a hyperlink within the first location, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device.
- 45. (New) A computer program product, comprising:
- a computer program processable by a computer system for causing the computer system

to:

- store an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper, wherein the paper is at least one of the following: a newspaper; a magazine; and a journal;
- at a first location within the electronic version, detect a reference to a second location within the electronic version, wherein the detected reference includes a page number of the second location; and
- in response to the detected reference, embed a hyperlink within the first location, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device; and

apparatus from which the computer program is accessible by the computer system.

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### REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 3, 4, 7-9, 11, 12, 15-17, 19, 20, 23 and 24 have been amended. Claims 25-45 have been added. Claims 1-45 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims (e.g., including, but not limited to, the discussion of Figs. 1, 2, 3z, 3aa, 3bb, 5, 6, 7, 8a and 8b). No new matter has been added.

### Substitute Title

Applicant respectfully asks the Examiner to formally accept the substitute title.

### 35 U.S.C. § 112

The Office Action rejected claims 1, 9 and 17 under 35 U.S.C. § 112, second paragraph. Applicant has made an earnest attempt to amend the claims in a manner that overcomes such rejection. The amended claims no longer include the following phrases, which were cited in the Office Action: "storing a version of a hardcopy paper"; "content of the likeness"; "the detected reference being associated with a second location"; "embedding a link within the version between the first location and the second location"; and "the first location being: displayable on the display device as part of the likeness."

### 35 U.S.C. § 103(a)

In the Office Action mailed July 26, 2005, claims 1, 3, 9, 11, 17 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0200507 ("Stern") in view of U.S. Patent No. 6,763,496 ("Hennings").

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### Stern is not a prior art reference in this case

As explained in Applicant's previous Response to Office Action (filed by Applicant on July 5, 2005), Applicant's patent application claims priority to Applicant's U.S. Provisional Patent Application No. 60/208,015, filed *May 26, 2000* ("Applicant's May 26, 2000 Application"). By comparison, Stern's corresponding provisional patent application was subsequently filed *June 16, 2000*. Thus, Applicant's May 26, 2000 Application was filed *before* Stern, and *Stern is not a prior art reference in this case*.

Antecedent basis for claims 1, 3, 9, 11, 17 and 19 is located throughout Applicant's May 26, 2000 Application (e.g., including, but not limited to, the discussion at pages 10-15 of Applicant's May 26, 2000 Application). Applicant explained this fact in Applicant's previous Response to Office Action (filed by Applicant on July 5, 2005), but the Examiner did not comment on this fact.

Thus, if the Examiner continues to rely upon Stern in rejecting claims 1, 3, 9, 11, 17 and 19, then Applicant respectfully submits that the Examiner should *not* issue a "final" Office Action in this case, until after the Examiner: (a) explains how Stern qualifies as a prior art reference; and (b) permits Applicant to address such explanation in a subsequent Response to Office Action.

### Hennings fails to teach claims 1, 3, 9, 11, 17, 19, 43, 44 and 45

Hennings fails to teach the combination of elements in claims 1, 3, 9, 11, 17, 19, 43, 44 and 45, and Hennings also fails to teach, or even suggest, any basis for combining in a 35 U.S.C. § 103 rejection. MPEP § 2143.01 states: "The mere fact that references can be combined or modified does *not* render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..."

MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's

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disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to claims 1, 3, 9, 11, 17, 19, 43, 44 and 45, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

Thus, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

### Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 3, 9, 11, 17, 19, 43, 44 and 45.

Dependent claims 2, 5-8 and 25-30 depend from and further limit claim 1 and therefore are allowable.

Dependent claim 4 depends from and further limits claim 3 and therefore is allowable.

Dependent claims 10, 13-16 and 31-36 depend from and further limit claim 9 and therefore are allowable.

Dependent claim 12 depends from and further limits claim 11 and therefore is allowable.

Dependent claims 18, 21-24 and 37-42 depend from and further limit claim 17 and therefore are allowable.

Dependent claim 20 depends from and further limits claim 19 and therefore is allowable.

An early formal notice of allowance of claims 1-45 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

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Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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